

### REMARKS

The Office Action of March 13, 2006 has been carefully studied. All claims except 4-6 and 31 are allowed, and claim 7 is objected to.

The following paragraphs correspond to the paragraphs of the Office Action:

Claims 4, 6 and 31 were rejected under 35 U.S.C. 102(e) as being anticipated by Sixl (6,479,432).

By inspection, it is clear that Sixl is directed to a herbicidal formulation wherein the invention is in the technique of maintaining herbicidally active compounds from the group of sulfonylureas in suspended form. In order to achieve this objective, the sulfonylurea is ground with an organic solvent and one or more non-ionic emulsifiers, and optionally one or more ionic emulsifiers and thickeners. According to column 12 lines 21-25 and line 55, through column 13 line 18, as one of the preferred solvents, there is mentioned the methyl ester of rapeseed oil, in particular in a mixture with an aromatic solvent. Furthermore, the patent provides for the optional addition of a thickener which the Examiner has characterized as a viscosifier and a weighting agent.

In the Office Action, it is stated that "Genapol" is an alcohol as in Applicants' claim 6. However, according to the Clariant website, Genapol is defined as "**Genapol types are anionic and non-ionic surfactants used in various applications**". (Emphasis added) This is corroborated by the fact that all the various Genapols mentioned in the patent are "ethoxylated". This means that an alcohol, for example, isotridecyl alcohol can be reacted with a string of ethoxy groups in order to make a non-ionic surfactant. Accordingly, even if there were a terminal hydroxy group at the end of the chain of ethoxy groups, the resultant compound would not be considered an alcohol like Applicants' alcohol which is a solvent, since on information and belief, non-ionic surfactants are not characterized as solvents. Furthermore, hydro-alcohols or mixtures of water and alcohols, are solvents which are not in any way similar to the non-ionic ethoxylated compounds characterized under Genapol. Consequently, claim 6 has not been amended, but instead two dependent claims are added, claim 35 characterizing the formulation as non-herbicidal and claim 36 characterizing the at least one solvent as an hydroalcoholic mixture.

Referring now to the amendments to claims 4, 5 and 31, it is seen that claims 4 and 31 are characterized by amending the formulation so that it is a non-herbicidal organic emulsion-breaking formulation. Whereas the original application does not contain the express verbiage "non-herbicidal", it is respectfully submitted that since the invention as described in the application is directed to breaking emulsions in the context of well bores drilled in oil-base mud, one of ordinary skill in the petroleum recovery field would appreciate that the present invention has nothing whatsoever to do with herbicides. Under the landmark decision *Vas-Cath v. Mahurkar* 935 Fed. 2nd 1555, 19 USPQ 2nd 1111 (Fed. Cir. 1991), the test for sufficiency of support in a parent application is whether the disclosure of the application reasonably conveys to an artisan that the inventor had possession of the later claimed subject matter at the time of the filing of the application. Most assuredly, one of ordinary skill reading the present application would appreciate the fact that the inventors of the present application had possession of a non-herbicidal composition. However, if the Examiner is of a different opinion and wishes the claims to be amended in a different manner than introducing the expression "non-herbicidal", the Examiner is courteously invited to telephone Counsel at the number indicated below so as to discuss the matter.

It is also clear that once the term "non-herbicidal" is introduced into claims 4 and 31, that the rejection on the grounds of anticipation can no longer be maintained. It is also of interest to note that Sixl must contain a non-ionic emulsifier in the composition so as to keep the sulfonylurea in suspension, i.e. the emulsifier is maintained in the composition which is quite the opposite of Applicants' composition wherein the objective is to be break an emulsion rather than to stabilize a suspension.

With respect to new dependent claim 37 which is dependent on claim 31, the viscosifying agent and the weighting agent are defined as two different compounds, thereby, in itself, distinguishing the invention of that new claim over that of the reference.

As for the rejection over Starch 5,888,492, the patent is directed to a rinse-off skin conditioning composition. It is apparent that such compositions would not include a weighting agent since there would be no reason to add same, and if added, could produce adverse affects on the skin. Thus, it is seen that claim 21 which contains the weighting agent is allowed.

Accordingly, claim 5 is now amended to include the weighting agent, which presumably will make claim 5 allowable as well.

As for the objection to claim 7, it is now placed in independent form.

In view of this response to the Office Action, it is believed that all the claims are now allowable, but if there are any remaining issues which can be expeditiously resolved by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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